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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,097	10/31/2003	Edward H. Overstreet	AB-378U	9705

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EXAMINER

FAULCON JR, LENWOOD

ART UNIT PAPER NUMBER

3762

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

<b>Office Action Summary</b>	<b>Application No.</b> 10/698,097	<b>Applicant(s)</b> OVERSTREET ET AL.	
	<b>Examiner</b> Lenwood Faulcon, Jr.	<b>Art Unit</b> 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see page 22 lines 6-9, filed September 12, 2005, with respect to the rejection(s) of claim(s) 1-4, 7, 10-12, 14, 16-17 and 19 under 35 USC § 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of John (U.S. Patent No. 6,066,163), based on Applicant's Amendments filed on September 12, 2005.

### ***Claim Rejections - 35 USC § 102***

2. Claims 1-4, 7, 10-12, 14, 16-17, 19, 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by John (U.S. Patent No. 6,066,163).

John teaches of an implantable adaptive brain stimulation method and system, comprising adjustable stimulation parameters (col. 3 lines 26-34), delivering electrical stimuli to at least two electrode contacts that output an electric current into the tissue (col. 3 lines 9-16), and a separate sensor for monitoring for the occurrence of evoked potentials (col. 13 lines 63-67 and col. 14 lines 1-2). John also teaches that the system is capable of delivering sequential or simultaneously electrical stimuli (col. 12 lines 46-49). John further teaches that the system and method can be used in the treatment of sensory disorders by sensory aids that stimulate the central nervous system or sensory pathway, such as a multi-channel implantable neural stimulator which functions as an auditory prosthesis (col. 14 lines 63-67).

***Claim Rejections - 35 USC § 103***

3. Claims 5-6, 8-9, 13, 15, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over John (U.S. Patent No. 6,066,163) as applied to claims 1-4, 7, 10-12, 14, 16-17, 19 and 21-23 above, view of Doyle (U.S. Patent No. 6,175,767).

Doyle teaches of a multichannel implantable inner ear stimulator that modulates channel streaming with audio information to produce hearing for the profoundly deaf or those with other hearing impediments (col. 7 lines 24-24). Doyle further teaches of adjusting the gradient field generated by electrodes placed in proximity to the 8<sup>th</sup> nerve (col. 7 lines 45-51). Doyle also teaches of plotting the threshold intensity that is just capable of exciting an axon and its relationship to the duration of the stimulus current (col. 12 lines 49-61).

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of John with the teachings of Doyle to have implantable multichannel cochlear implant that forms a contour plot of intensity levels associated with electrodes at which the first evoked action potential. John and Doyle both teach of multichannel implantable hearing devices, and thus teach of analogous arts. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the system and method as taught by John by including a contour of intensity levels associated with electrode contacts at which the evoked potential is first observed as taught by Doyle in order to define stimulation parameters for use in the implanted system, since plots are commonly used to determine parameters. It would have been obvious to make such a modification to John teaches of using a sensor

communicating with a processor that also communicates with a memory to provide values for stimulation parameters (col. 4 lines 26-51), and teaches of determining the threshold stimulation level for at least one stimulation mode of the system (col. 7 lines 8-14). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of John and Doyle to have the limitations of claims 5-6, 8-9, 13, 15, 18 and 20.

#### ***Double Patenting***

4. Claims 1-20 stand provisionally rejected on the ground of nonstatutory double patenting over claims 1-6 of copending Application No. 10/698,098. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: a neurostimulator implant system that applies electrical stimulation to the tissue of a patient by multiple electrode contacts, adjusting the intensity of the applied electrical stimulus to which the first presence of an evoked compound action potential is detected, determining the intensity threshold level, creating a contour of intensity levels for use in defining operational parameters of the neurostimulator implant system.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other

copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### **Conclusion**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Faltys et al. (U.S. Patent No. 5,626,629), King (U.S. Patent No. 5,702,429), Nygard et al. (U.S. Patent No. 5,758,651), Ren et al. (U.S. Patent No. 5,776,179), Hochmair et al. (U.S. Patent No. 5,876,443), Faltys et al. (U.S. Patent No. 6,157,861), Carter et al. (U.S. Patent No. 6,205,360), Overstreet (WO 03/015863), Faltys (U.S. 10/218,616).

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3762

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lenwood Faulcon, Jr. whose telephone number is 703-305-0582. The examiner can normally be reached on Monday-Thursday from 9 to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela D. Sykes, can be reached on 703-305-0582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Lenwood Faulcon, Jr.

  
George Manuel

Primary Examiner